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| GREGORY CHARLES FLICKINGER 223 PHEASANT RUN SE ROME, GA 30161 | | | EXAMINER ALPERT, JAMES M | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 3624 | |

DATE MAILED: 01/30/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/740,051

Applicant(s)

FLICKINGER ET AL.

Examiner

James Alpert

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 July 0205.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

The following communication is in response to Applicant's amendment filed on 02/28/2005, a personal interview conducted on 07/19/2005, and further remarks filed by applicant on 08/22/2005.

Summary of Prosecution

Applicant's amendment of 02/28/2005 was entered, and a final rejection was mailed 06/02/2005. The substance of a telephonic interview conducted on 07/19/2005 focused on whether Provisional Application #60172351, supporting the Suliman reference, U.S. Patent Application Publication #20010053980, was sufficient to enable the utility application. The remarks of 02/28/05 and 08/22/05 lay out in detail the assertions of the applicant as they relate to this issue of enablement.

Response to Arguments

In the telephonic interview, the examiner agreed that if upon further consideration of the references, Applicant's opinion regarding the provisional application was found persuasive, the final rejection would be withdrawn. The examiner has considered the observes the following:

1. Paragraph 37 of the utility application, while not duplicated in the provisional application, is enabled by the provisional application at (Page 2, starting at the paragraph beginning with "To register...") through (Page 3, including the paragraph beginning with "When, for example, customer...") These paragraphs detail the registration process that stores consumer information, assigns a unique customer identifier, and then as products are purchased, the consumer

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- information with specific product information, including make, model, serial number, and date of purchase.
2. Paragraph 45 of the utility application is not directly supported by the provisional application.
 3. Paragraph 52 of the utility application, while not duplicated in the provisional application, is enabled by the provisional application at (Page 2, starting at the paragraph beginning with "To register...") through (Page 3, including the paragraph beginning with "When, for example, customer...") These paragraphs detail the registration process that stores consumer information, assigns a unique customer identifier, and then as products are purchased, associates in a database, the consumer information with specific product information, including make, model, serial number, and date of purchase.
 4. Paragraph 62 of the utility application is not directly supported by the provisional application. The examiner observes that while an "account summary page" described in the utility application is not directly supported, given that the underlying information that would appear on such a page can be accessed by the invention as enabled by the provisional application, this fact does not appear to be particularly significant, as will be discussed below.
 5. Paragraph 66 of the utility application is directly supported by the provisional application at (Page 3, starting with final paragraph, through Page 4, at the conclusion of the top paragraph).

6. Paragraph 77 is not directly supported by the provisional application.

Applicant's request for reconsideration of the finality of the rejection of the last Office action is persuasive as to the finality of the action, and the finality of that action is withdrawn. Further, Applicant's arguments with respect to the Suliman reference have been considered, and those section of the utility application not supported will not be relied on in new grounds of rejection discussed below

New Grounds of Rejection – Claim Rejections - 35 USC § 103(a)

The text of 35 U.S.C. §103, which is not included in this action, can be found in a prior Office action. Claims 1,3-18,21-23 are rejected under 35 U.S.C. §103(a) as being unpatentable over Suliman in view of Cheng et al, U.S. Patent #6457076. Claims 2,19-20,24 are rejected under §103(a) as being unpatentable over Suliman in view of Cheng and further in view of Rogers, U.S. Patent #5978774.

With regard to Claims 1,12,18 Suliman teaches a method comprising:
providing an electronic registration database; (Para. 11 lines 1-3)

With regard to the following limitation:
providing an electronic data file comprising data specific to an entity that purchases or owns assets,

Suliman teaches this limitation at (Para. 37 lines 5-10). Applicant has further amended the claims to further comprise:

wherein the electronic data file is in the possession of the entity;

Suliman does not expressly refer to this limitation in the utility application. A small file containing information about the user is part of many different systems that involve using personal data when it will be used on a repeated basis. Cheng teaches such a file

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in an analogous application involving registration of software products. See Chang at (Col. 7, lines 12-39; Col. 8, lines 44-54; Col. 13, lines 29-45; Col. 24, lines 63 – Col. 25, line 4). These passages refer to customer information that is stored on a client computer for use in updating software files. It would have been obvious to one of ordinary skill in the art at the time Applicant's invention was made to combine the teachings of Suliman, relating to a consumer/product registration system, with the teachings of Cheng, relating to maintaining a small data file contain personal information. The motivation for such a combination is found in Suliman at (Para. 8) which indicates that these registration systems are designed to simplify and automate the collection of consumer and product information. Certainly, maintaining a small file as described in Cheng will further automate the system. As well, automation and simplification are well within the general knowledge of one possessing ordinary skill in the art. See In re Kotzab, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000); In re Lee, 277 F.3d 1338, 1342-44, 61 USPQ2d 1430, 1433-34 (Fed. Cir. 2002); In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); In re Jones, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

Continuing, Suliman does not expressly teach the next limitation:

extracting the data specific to an entity from the electronic data file and entering it into the registration database;

However, as pointed out in a previous action, this limitation is old and well known. A very common example is what is known in Internet technology as a "cookie." Applicant, while conceding that a cookie is a data file, argues that its use is limited to identifying a computer. The examiner disagrees. It is well known that a cookie is a small text file that attaches to a user's hard drive while the user is browsing a Web site. A

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cookie can contain information such as user ID, user preferences, archived shopping cart information, and other items such name, postal address, e-mail address, telephone number, etc. The examiner interprets the above limitation to be precisely the type of technology that is characterized by extraction of a cookie. The data file described above in the Cheng reference is actually a good piece of evidence of the type of file extraction that takes place over the Internet. MPEP § 2144.03(C) states, in respect to an Examiner's use of Official Notice:

To adequately traverse such a finding [of Official Notice], an applicant must specifically point out the supposed errors in the examiner's action, which would include stating why the noticed fact is not considered to be common knowledge or well-known in the art. See 37 CFR 1.111(b).

The same section continues:

If applicant does not traverse the examiner's assertion of official notice or applicant's traverse is not adequate, the examiner should clearly indicate in the next Office action that the common knowledge or well-known in the art statement is taken to be admitted prior art because applicant either failed to traverse the examiner's assertion of official notice or that the traverse was inadequate. If the traverse was inadequate, the examiner should include an explanation as to why it was inadequate.

Applicant has not stated why the noticed fact is not considered to be common knowledge or well-known in the art. Applicant has merely suggested there is a difference in a file comprising a cookie and the data file disclosed by Applicant. Applicant has not challenged the notion that extraction of files is old and well known. As such, the Examiner is now obligated to consider as admitted prior art, the limitation above.

Given the above, the examiner would observe that it would have been obvious to one of ordinary skill in the art at the time applicant's invention was made to combine the teachings of Suliman, relating to a registration database and corresponding customer information data file, with an extraction technology. The motivation for such a

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combination is to increase the speed with which the system operates. The method of extraction of the file would obviously save time to a user who would otherwise be required to type in information, over and over. Speeding up speed in use is a continuing objective of computing systems, and is clearly knowledge that is generally available to one of ordinary skill in the art. As mentioned above, Suliman also expressly remarks that simplification and automation are goals in improving systems.

Continuing, Suliman teaches the method further comprising:

associating the data specific to the entity and the data specific to the asset, thereby registering the asset for the entity. (Para. 81 lines 16-17, Para. 37 lines 15-17)

With regard to Claim 2, Suliman teaches the method wherein

registration is performed during the purchase of the asset. (Para. 12, lines 1-3)

This portion of the reference is supported in the provisional application at (Page 3, 2nd full paragraph). If applicant disagrees with this analysis, in the alternative, consider that the Rogers reference teaches this limitation at (Col. 2, lines 28-45), describing point-of-sale registration. It would have been obvious to one of ordinary skill in the art at the time applicant's invention was made to combine the teachings of a Suliman/Cheng combination, relating to a registration database and corresponding customer information data storage file, with the teachings of Rogers, relating to point-of-sale product registration. The motivation for such a combination is simply to increase confidence in the system by eliminating any possible errors that could occur from registering at a later time, for example forgetfulness, memory deletion, etc.

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With regard to Claims 3, 13 stating:

the method of claim 1, wherein the electric file is provided on a media that is loaded onto a purchasing entity's or owner entity's computer.

This claim is inherent to any type of file maintained on computer memory, and would include the type disclosed by a Suliman/Cheng combination.

With regard to Claim 4, stating:

the method of claim 3, wherein the data specific to an entity is extracted by an application on a second computer through a computer network, such as the Internet.

This claim is rejected under a similar analysis as the limitation in Claim 1, describing extraction.

With regard to Claims 5,14 stating:

the method of claim 1, wherein the electronic file is installed on a media accessible to a third party's computer.

This claim is inherent to any system executing a remote extraction. That is, in any situation where data would be remotely extracted, it is inherent that the remote computer would have to obtain access to the computer from which it expects to extract data. As such this claim is rejected under a similar analysis as Claim 4.

With regard to Claims 6,15 stating:

the method of claim 5, wherein the third party is a credit card company.

The examiner has provided documentary evidence, specifically, the Herz reference, U.S. Patent #6571279, in a previous action as to why this limitation is well known, and obvious. Applicant has not challenged this reference, and pursuant to MPEP §2144.03(C), the examiner deems the noticed fact as admitted. Applicant has argued that the motivation to combine is hindsight. To the contrary, and as Herz

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suggests, card companies possess a compelling interest in product registration. The motivation to combine is found in Herz, which describes monitoring spending patterns of customers as important to card companies. In addition, monitoring warranty issues as they relate to card backed reimbursement would be motivation to maintain a registration system. This fact is not hindsight, but is simply knowledge generally available to one of ordinary skill in the art.

With regard to Claims 7,16 Suliman (as supported by the provisional application) does not expressly teach the method wherein:

the data file is an electronic file installed on a smart credit card.

However the examiner takes Official Notice that the use of smart cards for storing personal information of the type disclosed by applicant is very old and well known in the art. Smart-card technology is well established, and to modify the point-of-sale technique described in Claim 2 to utilize smart cards in the sales and registration process is obvious. The motivation for modifying the system to include smart card technology is simply is to diminish processing speeds in that retrieving stored information is faster than giving information at the point of sale. This is knowledge generally available to one of ordinary skill in the art.

With regard to Claims 8-9, 17 stating:

the method of claim 1, wherein the data file includes data for insuring an asset, and

wherein an insurer has access to the electronic registration database and automatically insures an asset when it is registered.

Applicant is reminded that claims may be given the broadest reasonable interpretation. In re Hyatt, 211 F.3d 1367, 1372, 54 USPQ2d 1664, 1667 (Fed. Cir.

2000). The examiner asserts that warranty protection is a form of insurance. That is to say, the price of goods takes into consideration the necessity of manufacturers to occasionally replace an item that breaks, is defective, or even subject to user neglect that is later claimed to be a defect. To that extent, much of the entire Suliman reference is directed toward automatically insuring an asset.

With regard to Claim 10, Suliman teaches a method wherein:

the registration database provides a composite record of assets registered by specific entities and allows for the reporting and manipulation of the same. (Para. 52)

With regard to Claim 11, Suliman teaches a method wherein:

entities maintain control over personal, and or entity registration data. (Para. 66)

With regard to Claim 19, Suliman does not expressly teach the method wherein:

asset specific data is not manually provided by the entity and the entering of said data does not depend on the entity directly providing said asset specific data.

However, Rogers teaches this limitation at (Col. 2, lines 28-45), describing point-of-sale registration. It would have been obvious to one of ordinary skill in the art at the time applicant's invention was made to combine the teachings of a Suliman/Cheng combination, relating to a registration database and corresponding customer information storage data file, with the teachings of Rogers, relating to point-of-sale product registration. The motivation for such a combination is simply to increase confidence in the system by eliminating any possible system errors that could occur from registering at a later time, for example, forgetfulness or memory deletion, etc. This motivation is knowledge generally available to one of ordinary skill in the art.

With regard to Claim 20, Suliman does not expressly teach the method wherein:

said asset data is obtained at the time of purchase of the asset.

However this claim is rejected under a similar analysis as in Claims 2,19.

With regard to Claim 21, Suliman teaches the method wherein:

said data specific to an entity is extracted at the time of purchase of the asset.
(Para. 12, lines 1-3)

This portion of the reference is supported in the provisional application at (Page 3, 2nd full paragraph).

With regard to Claim 22, Suliman teaches the method wherein:

data file is located on the entity's computer and at least a subset of said data specific to the entity is entered into the electronic data file by the entity.

In terms of the data file itself, this would be inherent to the system as described in the analysis of the 2nd limitation of Claim 1, and is likewise rejected in view of a Suliman/Cheng combination. In reference to entry of data by the entity, Suliman teaches this method at (Paras. 37,51)

With regard to Claim 23, Suliman teaches the method wherein:

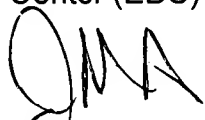
the entity is able to directly modify the entity specific data. (Paras. 37,51)

With regard to Claim 24, this claim is essentially the same as claim 1 with the exception that there is a prohibition of manual entry by the entity regarding asset data. However, as discussed in relation to Claims 2 and 19-20, Rogers teaches this missing limitation. This claim is thus rejected over Suliman in view of Cheng in further view of Rogers under the same rational as discussed in Claims 2 and 20.

Conclusion

THIS ACTION IS NON-FINAL. Any inquiry concerning this communication or earlier communications from the examiner should be directed to James Alpert whose telephone number is (571) 272-6738. The examiner can normally be reached on M-F 9:30-6:00. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on (571) 272-6747. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197.


James M. Alpert
January 12, 2006



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